

(3) In the present Office Action, dated July 19, 1999, the Examiner has objected to the Specification due to “incorporation of subject matter into this application by reference” to certain co-pending applications.

The applicants respectfully thank the Examiner for indicating that the reference “is improper because the information would be disclosed to the public if the application is in a condition of allowance”. However, the applicants respectfully submit that the reference to related applications does not seek to incorporate either essential or non-essential subject matter into the present application. The reference is made for the purpose of candor, not for the purpose of incorporation of subject matter. The *MPEP* at 608.01(p) states that: “Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph.”

(4)(a) In the present Office Action, the Examiner has rejected claims 1 and 6 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,293,310 issued March 8, 1994 to Carroll et al (hereinafter referred to as *Carroll*).

It should be noted that *Carroll* is assigned to the assignee of the present invention and that Terri A. Carroll and Jacques E. Hasbani are inventors in common.

In rejecting claim 1, the Examiner stated that:

... Carroll teaches the invention substantially as claimed, comprising the steps: ... (b) uploading a set of object tables from the client data processing system to the host data processing system (col. 6, lines 57-59);

The applicants respectfully submit that the Examiner has imputed characteristics and properties to *Carroll* that were neither contemplated nor taught by *Carroll*.

The use of objects to carry data, store instructions, provide functionality, and establish their own interface through stored instructions, provides value to objects that was never possible with stored table data such as is found in *Carroll*. Additionally, *Carroll* neither taught nor disclosed that a set of data objects within a Data Access System could be updated; this fundamental element is part of the applicants' preamble to claim 1 because the object oriented programming environment, which was never contemplated by *Carroll*, serves as the basis for the data processing environment of the applicants' claimed invention. If *Carroll* neither taught, nor even suggested, that object oriented programming was possible, let alone that it was advantageous in saving time and memory resources within its host system, then *Carroll* can't support the Examiner's premise that *Carroll* teaches the invention substantially as claimed.

The applicants respectfully submit that *Carroll* never uploaded object tables as is claimed in the applicants claim 1(b) because *Carroll* was not designed to do anything with objects or to function within an object oriented environment. And,

clearly objects and table data are not analagous. Therefore, if *Carroll* couldn't use the objects, then *Carroll* had no need to upload object tables.

In rejecting claim 1, the Examiner further stated that:

... Carroll teaches the invention substantially as claimed, comprising the steps: ... (c) reading the set of object tables at the host data processing system (read input file, 210 of fig. 13; col. 6, lines 65-68);

The applicants respectfully submit that *Carroll* neither taught nor suggested that reading the set of object tables of the applicants' claimed invention was possible; and, even if *Carroll* could read the object tables, *Carroll* would have not been able to do anything with the objects because *Carroll* couldn't function within an object oriented environment. Additionally, the reading of an input file (as described in *Carroll*) is not analagous to reading object files. An input file, as taught by *Carroll*, contains rate data (or the like), upgrades or modifications that are added to pre-existing files that can be accessed to determine specific rates for a transaction under specific circumstances (*Carroll* at column 13, lines 32-41). An object table, on the other hand, stores objects that are to be utilized not only for their data content, but for the functionality they contain (Specification at page 7, lines 25; and, at page 18, lines 13-23).

In rejecting claim 1, the Examiner additionally stated that:

... Carroll teaches the invention substantially as claimed, comprising the steps: ... (d) determining which data objects in the set of object tables is to be updated (load update 220 of fig. 13) and further determining which data objects in the set of object tables is to be maintained (reject update 224 of fig. 13); (e) constructing a new set of object tables from the host data processing system to the client data processing system (update

format to be sent to the user station 10, col. 7, lines 2-24); (f) transmitting the new set of object tables from the host data processing system to the client data processing system (update format to be sent to the user station 10, col. 7, lines 2-24; (g) verifying accurate receipt of the new set of object tables at the client data processing system (check to ensure the update information, col. 7, lines 21-24); and (h) restarting the client data processing system (user 10 will load the update information into the system, col. 7, lines 19-21).

The applicants respectfully submit that the properties attributed to *Carroll* by the Examiner are simply not possible within the limited data structures available to *Carroll*.

Further, in rejecting claim 6, the Examiner stated that:

... Carroll teaches the invention substantially as claimed, comprising: (a) a client data processing system; (b) a host data processing system (12 of fig. 1; 30 of fig. 6); (c) a data access system for storing and managing a plurality of object files (data center 14 of fig. 1; col. 7, lines 2-18, 47-62, storing and managing a plurality of object files, fig. 3-5); (d) communication means for linking the client data processing system with the host data processing system (see communication link between the carrier 1 and the user 1 through data center 14 of fig. 1); (e) first memory means for storing the plurality of object files (customized configuration database, 42 of fig. 9; col. 10, lines 26-50) and second memory means for predetermined set[s] of object files (discounts database and surcharges database, 44 and 46 of fig. 9; col. 10, lines 26-50).

For the reasons advanced and discussed above for claim 1, the applicants respectfully submit that the Examiner has not established a prima facie case of anticipation as is required. "A claim is anticipated only if each and every

element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” (*MPEP* at 2131).

Claims not specifically discussed above are believed allowable at least for the reasons advanced with respect to the claims from which they depend. Therefore, the applicants respectfully submit that the Examiner's rejection of claims 1 and 6 under 35 USC §102(b) is traversed by the Remarks made hereinabove.

(4)(b) In the present Office Action, the Examiner has rejected claims 2-3, 5, and 7-8 under 35 U.S.C. §103 as being unpatentable over *Carroll*.

The applicants incorporate the arguments raised in the Remarks hereinabove with respect to *Carroll* in traversing the rejection of the Examiner under §103.

The applicants respectfully submit that the Examiner has not established a prima facie case of obviousness as is required under §103.

To establish a prima facie case of obviousness under §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (*MPEP* at 2142 and 2143). The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. (*MPEP* at 2143).

The applicants' present application cannot, therefore, be obvious in light of *Carroll* because neither the reference alone nor together with knowledge generally available teaches nor suggests the applicants' claimed invention; it also would not be obvious to one of ordinary skill in the art to modify *Carroll* to achieve what the applicants have achieved. And, even if one of ordinary skill in the art were motivated to modify *Carroll*, the result would not be the applicants' claimed invention as per the Remarks made hereinabove or absent impermissible hindsight. The result would be a rating scheme utilizing one or more objects that contain data but no enabling functionality or the interface capability necessary to implement the functionality. Therefore, the applicants submit that the applied references do not provide the necessary suggestion to modify and/or combine their teachings as per the above Remarks; thus, the claimed invention can not be considered obvious over such a modification or combination in the absence of such a suggestion.

Further, if there is no support for the rejection of the independent claims 1 and 6 under §102(b), then the rejection of the dependent claims 2-3, 5, and 7-8 under 35 U.S.C. §103 as being unpatentable over *Carroll* is traversed as well.

Claims not specifically discussed above are believed allowable at least for the reasons advanced with respect to the claims from which they depend. Therefore, the applicants respectfully submit that the Examiner's rejection of claims 2-3, 5, and 7-8 under 35 USC §103 is traversed by the Remarks made hereinabove.

(5) In view of the above Amendments and Remarks, the applicants submit that the subject application is in condition for allowance, and further examination and reconsideration are respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Ronald Reichman", is written over a horizontal line.

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